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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,249	03/22/2004	Shinichi Kashimoto	04329.3290	9055
22852 7590 09/06/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER HASHEM, LISA	
			ART UNIT 2614	PAPER NUMBER
			MAIL DATE 09/06/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/805,249	Applicant(s) KASHIMOTO ET AL.	
	Examiner Lisa Hashem	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 3 recites the limitations "the other information terminal" and "said another information terminal". There is insufficient antecedent basis for these limitations in this claim.
3. Claims 4 and 5 recite the limitation "said another information terminal". There is insufficient antecedent basis for this limitation in these claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5 and 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 7,106,710 by Makineni et al, hereinafter Makineni.

Regarding claim 1, Makineni discloses a computer program (col. 3, lines 20-29), which is used to voice talking to cause an information terminal (Fig. 1, 16; i.e. client; laptop, handheld, smart-phone) (col. 3, lines 30-43) to execute voice talking (i.e. MS NetMeeting is a conferencing tool utilizing voice; col. 3, lines 44-51), managing an ID (i.e. identity) of the information terminal and a first address (i.e. permanent IP address) over a first network (Fig. 1, 12; i.e. home

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network), configured to store instructions for execution on a computer system (col. 3, lines 20-29) enabling the computer system to perform: determining that the information terminal moves over a second network (i.e. new location outside the home network) which is different from the first network; acquiring a second address over the second network; and transmitting a request for re-registering (i.e. registering the new address) a combination of the second address and the ID instead of the first address into another device (Fig. 1, 14; i.e. home network server) having a combination of the first address and the ID registered therein (col. 3, line 60 – col. 4, line 31).

Regarding claim 2, the voice talking program according to claim 1, wherein Makineni discloses the transmitting includes transmitting the first address in addition to the second address (col. 4, lines 4-31).

Regarding claim 3, the voice talking program according to claim 1, wherein Makineni discloses, in the case where the information terminal is in voice talk with the other information terminal (i.e. roaming mobile devices) and a request is made to said another device to relay a call control packet and a voice packet between the information terminal and said another information terminal, the transmitting includes requesting said another device to change an address of the voice packet to be transferred from said another information terminal to the information terminal, to the second address to be re-registered (col. 1, lines 30-48 and lines 56-67; col. 4, lines 20-24).

Regarding claim 4, the voice talking program according to claim 1, wherein Makineni discloses, in the case where the information terminal is in voice talk with said another information terminal (i.e. roaming mobile devices), a request is made to said another device to relay a call control packet between the information terminal and said another information

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terminal, and a voice packet is directly transmitted to and received from the information terminal, the transmitting includes requesting the another device to notify said another information terminal of the second address to be re-registered by means of the call control packet (col. 1, lines 30-48 and lines 56-67; col. 4, lines 20-24).

Regarding claim 5, the voice talking program according to claim 1, wherein Makineni discloses, in the case where the information terminal is in voice talk with said another information terminal (i.e. roaming mobile devices), a request is made to the another device to relay a call control packet between the information terminal and said another information terminal, and a voice packet is transmitted to and received from the information terminal, the transmitting includes transmitting the ID and the second address to said another information terminal (col. 1, lines 30-48 and lines 56-67; col. 4, lines 20-24).

Regarding claim 7, the voice talking program according to claim 1, wherein Makineni discloses the transmitting includes further transmitting the fact that a voice compression system which is different from a voice compression system applied to during utilization of the first address is applied during utilization of the second address (col. 4, lines 20-31).

Regarding claim 8, the voice talking program according to claim 1, wherein Makineni discloses the transmitting includes further transmitting the fact that a port number which is different from a port number applied during utilization of the first address is applied during utilization of the second address (col. 1, lines 30-48).

Regarding claim 9, Makineni discloses a voice talking method of causing an information terminal (Fig. 1, 16; i.e. client; laptop, handheld, smart-phone) (col. 3, lines 30-43)

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having an ID (i.e. identity) and a first address (i.e. permanent IP address) over a first network (Fig. 1, 12; i.e. home network) to carry out a voice talking (col. 3, lines 44-51), comprising: determining that the information terminal moves onto a second network (i.e. new location outside the home network) which is different from the first network; acquiring a second address (i.e. new IP address) over the second network; and transmitting a request for re-registering the second address (i.e. registering the new address) instead of the first address into another device (Fig. 1, 14; i.e. home network server) having the first address registered therein (col. 3, line 60 – col. 4, line 31).

Regarding claim 10, Makineni discloses a voice talking apparatus (Fig. 1, 16; i.e. client; laptop, handheld, smart-phone) (col. 3, lines 30-43) having an ID (i.e. identity) and a first address (i.e. permanent IP address) over a first network (Fig. 1, 12; i.e. home network), comprising: means for determining movement onto a second network (i.e. new location outside the home network) which is different from the first network; means for acquiring a second address (i.e. new IP address) over the second network; and means for transmitting a request for re-registering the second address (i.e. registering the new address) instead of the first address into another device (Fig. 1, 14; i.e. home network server) having the first address registered therein (col. 3, line 60 – col. 4, line 31).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Makineni.

Regarding claim 6, the voice talking program according to claim 1, wherein Makineni does not disclose said another device (Fig. 1, 14; i.e. home network server) is another information terminal which is a prospect voice talking party, or which is to be a voice talking party.

However, Makineni discloses connection with roaming mobile devices utilizing Mobile IP that utilizes a permanent IP address that is visible to applications and the user and maintains this IP address with these roaming mobile devices. Wherein the mobile devices can utilize MS NetMeeting as a peer-to-peer conferencing application that utilizes voice (col. 1, lines 30-48 and lines 56-67).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the voice talking program of Makineni to include said another device (i.e. roaming mobile devices) is another information terminal which is a prospect voice talking party, or which is to be a voice talking party. One of ordinary skill in the art would have been lead to make such a modification wherein a roaming user is connected to other mobile devices utilizing a voice conferencing application (i.e. MS NetMeeting). The devices utilize Mobile IP that employs two IP addresses.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 Form.

9. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communications intended for entry)

Or call:

(571) 272-2600 (for customer service assistance)

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

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11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lh

August 30, 2007


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